

Remarks

Claims 1-69 are pending.

Claims 1-69 are subject to restriction and election of species requirement.

Restriction Requirement

The Examiner has required restriction under 35 USC 121 to one of the two "inventions" identified as follows:

I - Claims 1-12 and 61-75, drawn to compounds, classified in class 568, subclass 763.

II - Claims 13-47, drawn to compounds, classified in class 514, subclass 731.

III – Claims 48-69, drawn to methods of use, classified in class 514, subclass 731.

The Examiner notes that inventions I and II are related as combination and sub combination. However, the Examiner contends that restriction is required and proper since the compounds of invention II (i.e., sub combinations), as claimed, could have separate utility such as antioxidants."

The Examiner further notes that inventions I and III are related as product and process of use. However, the Examiner contends that restriction is required and proper since the compounds of invention I, as claimed, "could have other uses such as antioxidants and polycarbonate intermediates."

Applicants respectfully traverse this restriction requirement.

Applicants believe that the Examiner has made an arbitrary separation of the inventions based on multiple classification listings. Each of the Examiner cited classifications relate to phenols. Consequently, a search of the specific phenol compounds would be the *same* regardless of the broad classification schemes encompassing them. More importantly, a search of the specific phenol compounds would necessarily uncover and, therefore, include a search of all potential uses, thus, imposing no additional searching burden on the PTO.

Furthermore, inventions I, II and III all disclose the same subject matter (i.e., phenols). Section 806.03 of the MPEP indicates that "[w]here the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction there between should never be required." Therefore, Applicants respectfully submit that the Examiner's restriction requirement under 35 USC §121 lacks support and is, therefore, improper.

Notwithstanding the aforementioned comments, should the restriction requirement be maintained, Applicants provisionally elect, with traverse, invention I.

Election of Species Requirement

The Examiner also contends that Claims 1-69 are Markush type claims reading on independent and distinct inventions. Specifically, the Examiner alleges that "[m]embers of the Markush group are so unrelated and diverse that a prior art reference anticipating the claims with respect to some of the members would not render the claims obvious under 35 U.S.C. §103 with respect to all of the other members", thus, in the Examiner's mind, requiring Applicants to, additionally, provisionally elect a single disclosed and claimed species of either invention I, II or III.

Applicants respectfully traverse this election of species requirement.

Claims 1-69 are directed to phenol compounds having antimicrobial properties. Under 35 USC §121, the PTO has authority to restrict an application to a single disclosed species where the claims cover two or more "independent and distinct" species. The phenol compounds of present invention, however, fail to meet this requirement; they are *not* "independent" (i.e., they do not lack commonality of design, operation or effect). All of the disclosed species are phenols and are directed to reducing or eliminating harmful microorganisms.

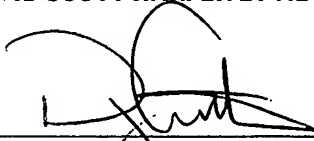
Furthermore, the Examiner provides no reason as to why the species *should be* considered independent and distinct. Applicants believe that the Examiner has made an arbitrary separation of species based on a plurality of species without explanation. Moreover, a search of the invention should be the same regardless of the specific phenol elected, thus, imposing no serious searching burden on the PTO. Accordingly, Applicants respectfully submit that the Examiner's election of species requirement under 35 USC §121 is improper and respectfully request that the requirement be withdrawn.

Notwithstanding the aforementioned comments, should the election of species requirement be maintained, Applicants provisionally elect, with traverse, 2-(isopropyl)-4-(3-hydroxybutyl)phenol.

In view of the foregoing remarks, it is respectfully requested that the Examiner withdraw his requirement for an election of species and allow the generic claims to be prosecuted on the merits in the present application. In the event that the Examiner's restriction and/or election of species requirement are made final, Applicants affirm the provisional elections made above. Claims 1-8, 11-18, 20-21, 24-34, 36-37, 40-57, 60-61, and 64-69 read on the elected species.

Respectfully submitted,

DAVID SCOTT HARPER ET AL

By 

Darryl C. Little
Attorney for Applicants
Registration No. 40,703
Phone: (973) 385-4401
FAX: (973) 385-3846
Customer No.: 29668

October 26, 2004

Morris Plains, NJ